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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/072,504	05/04/1998	MILTON HODOSH	760.1034	6613

7590

10/22/2003

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EXAMINER

KRASS, FREDERICK F

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 10/22/2003

36

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/072,504

Applicant(s)
Hodosh

Examiner
Frederick Krass

Art Unit
1614



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 and 26 is/are allowed.
- 6) ☒ Claim(s) 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Status of Case

Prosecution is hereby reopened.

Request for Interview

A new examiner has taken over prosecution of this case. The new examiner officially requests an interview with Applicant, preferably in person and with both Applicant and his representative both present. The subject of that interview will be the proposed Interference. The new examiner believes that given the history of this case, this is necessary to allow all parties sufficient time to come to an informed meeting of the minds.

Utility/Written Description Rejection

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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1) Claims 23-25 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility.

While it is of course the goal of all practitioners, "prevention" of dental hypersensitivity is not at this time achievable in any realistic sense. This is supported by the various art cited during the prosecution of this case. See for example Hodosh, "A Superior Densensitizer - Potassium Nitrate", JADA, vol. 88, pp. 831-32 (1974). As stated therein, attempts to eliminate dental hypersensitivity have "not been uniformly successful for various reasons." (See page 8 at the top of the righthand column).

Since "prevention" is not realistically achievable given the state of the art at this time, it is not a credible or well-established utility.

2) Claims 23-25 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since "prevention" is not a credible asserted utility or a well established utility for the reasons set forth above, the instant specification fails to provide an adequate written description to one skilled in the art of how to use the claimed invention to achieve that utility.

These rejections can be ameliorated by changing "preventing" to --- relieving --- at the first line of claim 23.

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick Krass whose telephone number is (703) 308-4335. The examiner can normally be reached on Monday-Friday from 9am to 5pm .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached at (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0193

FREDERICK KRASS
PRIMARY EXAMINER
GROUP 1600

